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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,834	12/24/2003	Hirokazu Sakai	247097US0	1125

22850 7590 04/02/2007  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
31 DAYS	04/02/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 31 DAYS from 04/02/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

## Office Action Summary

**Application No.**

10/743,834

**Applicant(s)**

SAKAI ET AL.

**Examiner**

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 6 is, drawn to hair cosmetic composition comprising A-C, wherein B is a cationic surfactant, classified in class 424, subclass 70.27.
- II. Claim 7 is, drawn to hair cosmetic composition comprising A-C, wherein B is a tertiary amine, classified in class 424, subclass 70.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are not obvious variants and the products are mutually exclusive since they do not overlap in scope. Art anticipating or rendering obvious tertiary amine will not anticipate or render obvious a cationic surfactant. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

#### ***ELECTION OF SPECIES***

This application contains claims directed to the following patentably distinct species: See below for species belonging to cationic surfactant.

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the cationic surfactant is selected from the group consisting of lauryl trimethylammonium chloride, cetyl trimethylammonium chloride, cetyl trimethylammonium bromide, stearyl trimethylammonium chloride, stearyl trimethylammonium bromide, lauryl trimethylammonium bromide, dialkyl dimethylammonium chlorides, dicetyl dimethylammonium chloride, distearyl dimethylammonium chloride, dicocoyl dimethylammonium chloride, myristyl dimethylbenzylammonium chloride, stearyl dimethylbenzylammonium chloride, lanolin fatty acid aminopropylethyldimethylammonium ethylsulfate, lanolin fatty acid aminoethyltriethylammonium ethylsulfate, lanolin fatty acid aminoethyldiethylmethylmmonium ethylsulfate, lanolin fatty acid aminoethyltrimethylammonium ethylsulfate, lanolin fatty acid aminopropyltriethylammonium ethylsulfate, lanolin fatty acid aminoethyltrimethylammonium methylsulfate, lanolin fatty acid aminopropylethyldimethylammonium methylsulfate, isoalkanoic acid (C14 to C20) aminopropylethyldimethylammonium ethylsulfates, isoalkanoic acid (C18 to C22) aminopropylethyldimethylammonium ethylsulfates, isostearic acid aminopropylethyldimethylammonium ethylsulfate, isononanoic acid aminopropylethyldimethylammonium ethylsulfate, alkyltrimethylammonium saccharines, and mixtures thereof.

The species are independent or distinct because they are divergent compounds. All the species are distinct and separate and it is a serious search burden to examine all the species in the patent and non-patent literature.

Applicant is required under 35 U.S.C. 121 to **elect a single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 6 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

#### ***ELECTION OF SPECIES***

This application contains claims directed to the following patentably distinct species: see below for species belonging to tertiary amine.

the tertiary amine type compound is selected from the group consisting of N,N-dimethyloctadecyloxypropylamine, stearamidopropyldimethylamine, and mixtures thereof.

The species are independent or distinct because both the compounds are distinct and separate. It is a search burden to examine the compounds in both the patent and non-patent literature.

Applicant is required under 35 U.S.C. 121 to **elect a single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 7 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

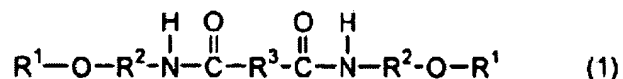
Claims 1-5, and 8-10 link(s) inventions I and II. The restriction requirement between the linked inventions is **subject to** the nonallowance of the linking claim(s), claims 1-5 and 8-10. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall** be withdrawn and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

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Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

### ***ELECTION OF SPECIES***

This application contains claims directed to the following patentably distinct species: The species belonging to an amphipathic amide lipid. See below for the species corresponding to formulae 1-4.

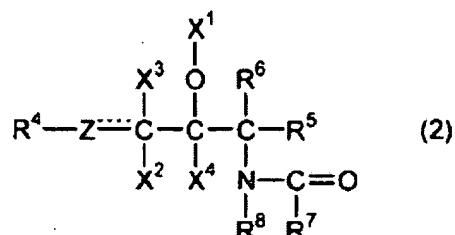


wherein, R<sup>1</sup> represents a linear or branched C<sub>1-12</sub> hydrocarbon group which may be substituted with hydroxy and/or alkoxy group(s), R<sup>2</sup> represents a linear or branched divalent C<sub>1-5</sub> hydrocarbon group, and R<sup>3</sup> represents a linear or branched divalent C<sub>1-22</sub> hydrocarbon group,



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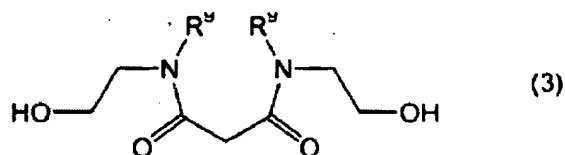
45



wherein,  $\text{R}^4$  represents a linear, branched or cyclic, saturated or unsaturated  $\text{C}_{4-30}$  hydrocarbon group which may be substituted with a hydroxy, oxo or amino group(s),  $\text{Z}$  represents a methylene group, a methine group or an oxygen atom, a broken line represents the presence or absence of a  $\pi$  bond,  $\text{X}^1$  represents a hydrogen atom, acetyl group or glyceryl group, or, together with the adjacent oxygen atom, forms an oxo group,  $\text{X}^2$ ,  $\text{X}^3$  and  $\text{X}^4$  each independently represents a hydrogen atom, a hydroxy group or an acetoxy group (with the proviso that when  $\text{Z}$  represents a methine group, one of  $\text{X}^2$  and  $\text{X}^3$  represents a hydrogen atom and the other does not exist, and when  $-\text{O}-\text{X}^1$  represents an oxo group,  $\text{X}^4$  does not exist),  $\text{R}^5$  and  $\text{R}^6$  each independently represents a hydrogen atom, a hydroxy group or a

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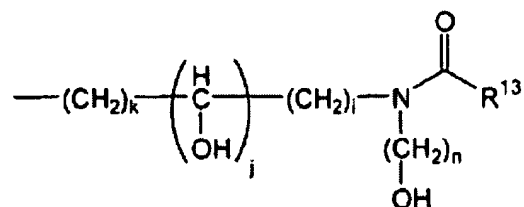
hydroxymethyl group,  $R^7$  represents a linear, branched or cyclic, saturated  $C_{5-35}$  hydrocarbon group which may be substituted with hydroxy or amino group(s), or the saturated  $C_{5-35}$  hydrocarbon group in which a linear, branched or cyclic, saturated or unsaturated  $C_{6-22}$  fatty acid which may be substituted with a hydroxy group is ester-bonded at the  $\omega$ -position of the hydrocarbon group, and  $R^8$  represents a hydrogen atom or a linear or branched, saturated or unsaturated hydrocarbon group which may have substituent(s) selected from a hydroxy group, hydroxyalkoxy groups, alkoxy groups and an acetoxy group and has 1 to 8 carbon atoms in total,



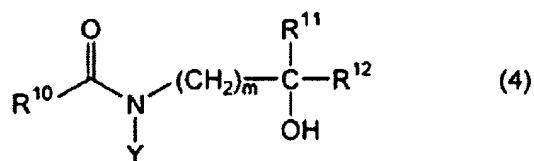
wherein,  $R^9$  represents a  $C_{10-18}$  alkyl group which may be substituted with hydroxy group(s), and

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group, Y represents a linear or branched, saturated or unsaturated C<sub>10-32</sub> alkyl group which may be substituted with hydroxy group(s), or a substituent represented by the following formula:



in which, k, i and n each stands for an integer of from 1 to 3, j stands for 0 or 1, and R<sup>13</sup> represents a linear or branched, saturated or unsaturated C<sub>9-31</sub> alkyl group which may be substituted with hydroxy group(s).



wherein, R<sup>10</sup> represents a linear or branched, saturated or unsaturated C<sub>9-31</sub> alkyl group which may be substituted with hydroxy group(s), or a 2-dodecen-1-yl succinic acid residue, m stands for an integer of from 1 to 3, R<sup>11</sup> and R<sup>12</sup> each represents a hydrogen atom or a C<sub>1-4</sub> alkyl or hydroxyalkyl

The species are independent or distinct because the formulae are drawn to divergent compounds. In each formula there are numerous compounds since there are many variables. Art anticipating or rendering obvious one formula will not anticipate or render obvious another formula. Due to numerous compounds in all the formulae, it is a serious search burden to examine all the amphipathic lipids in both the patent and non-patent literature.

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Applicant is required under 35 U.S.C. 121 to **elect a single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 3-5 and 8-10 are generic.

**Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

*In response to this office action, applicants are requested to specify the single compound and identify the variables that correspond to the compound.*

A telephone call was made to Richard Chin on 3/28/07 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and

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specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

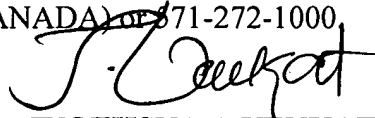
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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